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SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER JOO, JOSHUA	
			ART UNIT 2445	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/521,704

Applicant(s)

VAN LUIJT ET AL.

Examiner

JOSHUA JOO

Art Unit

2445

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-9,11 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,7-9,11 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/18/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

This Office action is in response to Applicant's communication filed on December 14, 2009.

Claims 1, 3, 7-9, 11, 14-21 are pending in the application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 14, 2009 has been entered.

Response to Arguments/Remarks

Applicant's arguments with respect to claims 1, 3, 7-9, 11, 14-21 have been considered but are moot in view of the new ground(s) of rejection. Applicant also argued that:

(1) Levy fails to disclose transmitting registered usage information when the registered usage information meets a predetermined criterion.

In response, Levy teaches that a user's home system reports registered usage information. As the claims do not define the predetermined criterion, an event that causes the system to transmit the registered usage information could be considered as the predetermined criterion. For instance, Levy teaches,

"For example, the billing and reporting system may be updated from the home system every two weeks or every month or so." (Paragraph 0058)

Levy suggests that registered usage information is reported based on a period of time. This appears to similar to what is described in the instant specification, which recites,

“When the recorded data meets a predetermined criterion, a reporting module 207 transmits the recorded data to the third party 130 to allow afterwards billing for sharing of the multimedia object 200 in accordance with the registered usage information for the multimedia object 200... Probably the most straightforward one is a fixed period of time, such as a week or a month, after the last time the usage information was transmitted.” (Page 8, lines 24-31)

It is also noted that Kutaragi US Patent No. 7,275,261 teaches of transmitting usage information when a number of times that the same content is utilized exceeds a predetermined number (Claims 1 and 4). A predetermined criterion could be when the content utilization exceeds a predetermined number. Therefore, transmitting registered usage information when the registered usage information meets a predetermined criterion is known in the art.

(2) Nothing in Levy ‘173 mentions billing and crediting the same user account

In response, Levy ‘173 teaches of billing a user account but does not teach of crediting the user account. Newly cited reference, Noll et al. US Publication No. 2002/0054087, teaches of billing and crediting a user account.

Information Disclosure Statement

The information disclosure statement (IDS) submitted December 18, 2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the IDS is considered by the Examiner.

Specification

The disclosure is objected to because it contains embedded hyperlinks and/or other form of browser-executable code. See pages 1 and 10. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 101

Rejections of claims 3, 7-9, 14-17 under 35 USC 101 set in the Office action dated September 28, 2009 is withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) Regarding claim 21, “the third party” has insufficient antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al. US Publication #2007/0294173 (Levy ‘173 hereinafter), in view of Levy, US Patent No. 7,689,532 (Levy ‘532 hereinafter) and Noll et al. US Publication No. 2002/0054087 (Noll hereinafter).

As per claim 1, Levy ‘173 teaches substantially the invention as claimed including a method of regulating sharing of multimedia object file by a device, the method comprising:

using the device to perform the following acts:

sharing the multimedia object file with other devices (Paragraphs 0011, 0057. Usage of content includes copying and distributing of content. Paragraph 0003. Content may include multimedia content.);

registering usage information for the shared multimedia object file using an identifier (Paragraphs 0057; 0061. Register usage based on ID.);

transmitting the registered usage information from the device to a billing server to bill a user account associated with the device by a first amount in accordance with the registered usage information for the multimedia object file (Paragraph 0057; 0061. Report usage for billing.);

Levy '173 does not specifically teach computing a fingerprint for least a portion of the multimedia object file to obtain an identifier for the multimedia object file. Levy '173 teaches of transmitting registered usage information but does not specifically teach recording user profile information for the user, the user profile information including a browsing behavior of the user to identify a multimedia interest of the user; and transmitting the recorded user profile information from the device to the billing server to credit the user account by a second amount, upon receipt of the recorded user profile information together with the registered usage information.

Levy '532 teaches of a file sharing software on a client computing a fingerprint for least a portion of a multimedia object file to obtain an identifier for the multimedia object file (col. 11, lines 24-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to compute a fingerprint for at least a portion of a multimedia object file to obtain an identifier for the multimedia object file. The motivation for the suggested combination is that Levy '532's teachings would enhance Levy '173's teachings by providing a unique identifier to augment tracking usage of files.

Noll teaches of recording user profile information for a user, the user profile information including a browsing behavior of the user to identify a multimedia interest of the user; and transmitting

the recorded user profile information from the device to a billing server to credit the user account by a second amount, upon receipt of the recorded user profile information (Paragraphs 0063, 0104, 0106. Client tracks viewing habits and preferences. Provide habits and preferences and credit user's account.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to record user profile information for a user, the user profile information including a browsing behavior of the user to identify a multimedia interest of the user; and transmit the recorded user profile information from the device to a billing server to credit the user account by a second amount, upon receipt of the recorded user profile information. The motivation for the suggested combination is that Noll's teachings would improve the suggested system by providing financial incentives to a user based on voluntary basis to report information, which may be used to determine advertisements and behaviors.

As per claim 19, Levy '173, Levy '532, and Noll teach the method of claim 1. Levy '173 teaches wherein the usage information for the multimedia object file comprises a duration of media content associated with the multimedia object file (Paragraph 0061. Determine amount of usage by counting watermarks embedded in video frames, e.g. 1 second interval.).

As per claim 21, Levy '173 does not specifically teach the method of claim 1, further comprising transmitting at least a portion of the user profile to the third party.

Noll teaches of transmitting a portion of the user profile to a third party (Paragraphs 0063, 0104, 0106)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to transmit a portion of the user profile to a third party. The motivation for the suggested combination is that Noll's teachings would improve the suggested system by providing

information used to determine advertisements and behaviors and providing financial incentives to a user to report the information.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable Levy '173, in view of Levy '532, Noll, and Sako et al. US Patent No. 7,062,467 (Sako hereinafter).

As per claim 18, Levy '173 does not specifically the method of claim 1, wherein the usage information for the multimedia object file comprises a number of times the multimedia object file is shared.

Sako teaches of registering a number of times content is shared (Abstract; col.1, lines 60-67; claim 21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the usage information as taught by the suggested system to comprise a number of times content is being shared as taught by Sako. The motivation for the suggested combination is that Sako's teachings would improve the suggested system by providing a specific basis for billing and allowing billing of content based on distribution of content.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levy '173, in view of Levy '532, Noll, and Kutaragi et al. US Patent No. 7,275,261 (Kutaragi hereinafter).

As per claim 20, Levy '173 teaches of sharing multimedia object but does not specifically teach the method of claim 1, wherein the predetermined criterion comprises a predetermined number of times the multimedia object file is shared.

Kutaragi teaches of monitoring utilizing condition of content, wherein utilization history is transmitted when a number of times of utilizing content exceed a predetermined number (claim 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the predetermined criteria to comprise a predetermined number of times the multimedia object is utilized. The motivation for the suggested combination is that Kutaragi's teachings would improve the suggested system by enabling reporting of usage information for billing based on other factors and enabling automatic transmission of usage information.

Claims 3, 8, 11, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy '173, in view of Levy '532, Ishibashi, WO 01/19017, March 15, 2001 (Translated equivalence, Ishibashi, US Patent No. 7,353,541, Ishibashi hereinafter), and Noll.

As per claim 3, Levy '173 teaches substantially the invention as claimed including a device arranged to share a multimedia object file, the device comprising:

file sharing means for sharing the multimedia object file with other devices (Paragraphs 0011, 0057. Usage of content includes copying and distributing of content. Paragraph 0003. Content may include multimedia content.);

identifying means for obtaining an identifier for the shared multimedia object file (Paragraph 0057; 0062. Identify unique ID. Paragraph 0052. Unique ID may be a digital watermark),

accounting means for registering usage information for the identified multimedia object file (Paragraphs 0057, 0061. Register usage for reporting);

reporting means for transmitting the registered usage information to a third party, when the registered usage information meets a predetermined criterion, to bill a user account in accordance with the registered usage information for the multimedia object file (Paragraph 0057; 0061. Report usage for billing.),

Levy '173 does not specifically teach the identifying means comprising a fingerprint calculator to obtain the identifier by computing a fingerprint for at least a portion of the multimedia object file;

wherein the device is to inhibit sharing of the multimedia object file in response to the reporting means failing to transmit the registered usage information to the third party; and user profile maintenance means for maintaining user profile information including browsing behavior of a user to identify a multimedia interest of the user.

Levy '532 teaches of a fingerprint calculator to obtain an identifier by computing a fingerprint for at least a portion of a multimedia object file (col. 11, lines 24-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the identifying means to comprise a fingerprint calculator to obtain the identifier by computing a fingerprint for at least a portion of the multimedia object file. The motivation for the suggested combination is that Levy '532's teachings would enhance Levy '173's teachings by providing a unique identifier to augment tracking usage of files.

Ishibashi teaches a similar system for maintaining utilization history of content, wherein a device is arranged to inhibit sharing of the multimedia object in response to the reporting means failing to transmit information used to determine usage fee to the third party (col. 20, lines 54-58; col. 97, lines 35-50. Detect charge information is uncollected and prevent reproduction of content).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to inhibit sharing of the multimedia object in response to the reporting means failing to transmit the information to the third party. The motivation for the suggested combination is that Ishibashi's teachings would improve the suggested system by preventing illegal reproduction of content (col. 97, lines 33-36).

Noll teaches of maintaining user profile information including browsing behavior of a user to identify a multimedia interest of the user (Paragraphs 0063, 0104, 0106. Client tracks viewing habits and preferences.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to implement a user profile maintenance means for maintaining user profile information including browsing behavior of a user to identify a multimedia interest of the user. The motivation for the suggested combination is that Noll's teachings would improve the suggested system by providing financial incentives to a user based on voluntary basis to report information, which may be used to determine advertisements and behaviors.

As per claim 14, Levy '173 teaches substantially the invention as claimed including a device configured to share a multimedia object file, the device comprising:

a file sharing module configured to share the multimedia object file with other devices (Paragraphs 0011, 0057. Usage of content includes copying and distributing of content. Paragraph 0003. Content may include multimedia content.);

an accounting module configured to register usage information for the multimedia object file, based on the identifier (Paragraphs 0057, 0061. Register usage for reporting.);

a reporting module configured to transmit registered usage information to a third party based on the registered usage information meeting a predetermined criterion to allow billing for sharing the multimedia object file in accordance with the registered usage information (Paragraph 0057; 0061. Report usage for billing.),

Levy '173 does not specifically teach a fingerprinting module including a fingerprint calculator configured to obtain an identifier for the multimedia object file by computing a fingerprint for at least a portion of the multimedia object file, the fingerprinting module being implemented using a processor; the device configured to inhibit sharing of the multimedia object file in response to the reporting means failing to transmit the registered usage information to the third party; and a user profile maintenance

module configured to maintain user profile information including browsing of a user to identify a multimedia interest of the user.

Levy '532 teaches of a fingerprint calculator to obtain an identifier by computing a fingerprint for at least a portion of a multimedia object file, the fingerprinting module being implemented using a processor (col. 11, lines 24-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the identifying means to comprise a fingerprint calculator to obtain the identifier by computing a fingerprint for at least a portion of the multimedia object file, the fingerprinting module being implemented using a processor. The motivation for the suggested combination is that Levy '532's teachings would enhance Levy '173's teachings by providing a unique identifier to augment tracking usage of files.

Ishibashi teaches a similar system for maintaining utilization history of content, wherein a device is arranged to inhibit sharing of the multimedia object in response to the reporting means failing to transmit information used to determine usage fee to the third party (col. 20, lines 54-58; col. 97, lines 35-50. Detect charge information is uncollected and prevent reproduction of content).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to inhibit sharing of the multimedia object in response to the reporting means failing to transmit the information to the third party. The motivation for the suggested combination is that Ishibashi's teachings would improve the suggested system by preventing illegal reproduction of content (col. 97, lines 33-36).

Noll teaches of maintaining user profile information including browsing behavior of a user to identify a multimedia interest of the user (Paragraphs 0063, 0104, 0106. Client tracks viewing habits and preferences.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to implement a user profile maintenance means for maintaining user profile information including browsing behavior of a user to identify a multimedia interest of the user. The motivation for the suggested combination is that Noll's teachings would improve the suggested system by providing financial incentives to a user based on voluntary basis to report information, which may be used to determine advertisements and behaviors.

As per claim 8, Levy '173, Levy '532, Ishibashi, and Noll teach the device of claim 3. Levy '173 teaches in which the usage information being registered for the multimedia object file comprises duration of media content associated with the multimedia object file (Paragraph 0061. Determine amount of usage by counting watermarks embedded in video frames, e.g. 1 second interval.).

As per claim 11, Levy does not specifically teach the device of claim 3, wherein the reporting means is to transmit at least a portion of the user profile to the third party.

Noll teaches of transmitting a portion of the user profile to a third party (Paragraphs 0063, 0104, 0106)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to transmit a portion of the user profile to a third party. The motivation for the suggested combination is that Noll's teachings would improve the suggested system by providing information to determine advertisements and providing financial incentives to a user to voluntarily report information.

As per claim 16, Levy '173, Levy '532, Ishibashi, and Noll teach the device of claim 14. . Levy '173 teaches in which the registered usage information being registered for the multimedia object

comprises duration of media content associated with the multimedia object file (Paragraph 0061.

Determine amount of usage by counting watermarks embedded in video frames, e.g. 1 second interval.).

Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable Levy '173, in view of Levy '532, Ishibashi, Noll, and Sako.

As per claim 7, Levy '173 does not specifically the device of claim 3, in which the usage information being registered for the multimedia object file comprises a number of times the multimedia object file is being shared.

Sako teaches of registering a number of times content is shared (Abstract; col.1, lines 60-67; claim 21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the usage information as taught by the suggested system to comprise a number of times content is being shared as taught by Sako. The motivation for the suggested combination is that Sako's teachings would improve the suggested system by providing a specific basis for billing and allowing billing of content based on distribution of content.

As per claim 15, Levy '173 does not specially teach the device of claim 14, wherein the registered usage information includes a number of times the multimedia object file has been shared.

Sako teaches of registering a number of times content is shared (Abstract; col.1, lines 60-67; claim 21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the usage information as taught by the suggested system to comprise a number of times content is being shared as taught by Sako. The motivation for the suggested

combination is that Sako's teachings would improve the suggested system by providing a specific basis for billing and allowing billing of content based on distribution of content.

Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy '173, in view of Levy '532, Ishibashi, Noll, and Kutaragi.

As per claim 9, Levy '173 teaches of sharing multimedia object but does not specifically teach the device of claim 3 in which the predetermined criterion comprises a predetermined number of times the multimedia object file has been shared.

Kutaragi teaches of monitoring utilizing condition of content, wherein utilization history is transmitted when a number of times of utilizing content exceed a predetermined number (claim 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the predetermined criteria to comprise a predetermined number of times the multimedia object is utilized. The motivation for the suggested combination is that Kutaragi's teachings would improve the suggested system by enabling reporting of usage information for billing based on other factors and enabling automatic transmission of usage information.

As per claim 17, Levy '173 teaches of sharing multimedia object but does not specifically teach the device of claim 14 in which the predetermined criterion comprises a predetermined number of times the multimedia object file has been shared.

Kutaragi teaches of monitoring utilizing condition of content, wherein utilization history is transmitted when a number of times of utilizing content exceed a predetermined number (claim 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the predetermined criteria to comprise a predetermined number of times the multimedia object is utilized. The motivation for the suggested combination is that Kutaragi's teachings

would improve the suggested system by enabling automatically reporting of usage information for billing for the usage of content as suggested by Kutaragi.

Conclusion

Examiner has cited particular sections of the reference(s) that are applied to the claims. While the sections are cited for convenience and are representative of the teachings of the prior art, other sections of the reference(s) may be relevant and applicable to the claims. It is respectfully requested that Applicant fully consider the reference(s) in its entirety when responding to the Office action.

A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Friday 7:30AM to 4:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell can be reached on 571 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Joshua Joo/
Examiner, Art Unit 2445